

PATENT

Application No.: 09/609,931  
Attorney Docket No.: 99-099**REMARKS**

Prior to entry of this Amendment:

- Claims 1-30, 33, and 35 were pending in the present application
- Claims 1-30, 33, and 35 stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims 1-30, 33, and 35 will be pending
- Claims 1, 13, 19, 20, 30, and 35 will be amended
- Claims 1, 30, 33, and 35 will be the only independent claims

**Claim Amendments****1. Claims 1, 30, and 35 have been amended**

Claims 1, 30, and 35 have been amended solely in order to expedite prosecution of the present application in light of the Examiner's Section 101 rejection. No new matter has been added.

In each of Claims 1, 30, and 35 a step generally directed to *receiving information* has been amended to recite *receiving such information at a processing device* (emphasis added). Applicants respectfully submit that Claims 1, 30, and 35 (and claims dependent therefrom) are directed to statutory subject matter.

Claim 1 has also been amended to recite a feature of *prompting an attendant to present the query*. No new matter has been added.

**2. Claims 19 and 20 have been amended**

Claim 19 has been amended in accordance with the amendment to Claim 1, from which Claim 19 depends. No new matter has been added.

Claim 20 has been amended to depend from Claim 1. Applicants note that Claim 20 now no longer explicitly recites a step of a particular mode of prompting an attendant, but simply adds the step of analyzing if the attendant properly presented the query to the method of Claim 1. No new matter has been added.

**3. Claim 13 has been amended**

Claim 13 has been amended to clarify that in some embodiments, a query may be identified based at least in part on an authority level of an attendant. [See, e.g., Specification, page 16, lines 4-7]. No new matter has been added. Applicants respectfully submit that Claim 13 contains allowable subject matter.

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Claims 1-20, 24-30, and 35 are rejected under 35 U.S.C. 101 "because the claimed invention is directed to non-statutory subject matter." [Office Action, page 2].

Applicants respectfully traverse the Examiner's Section 101 rejection. Applicants respectfully submit that Claims 1-20, 24-30, and 35 each produce a useful, concrete and tangible result, which is the only requirement under Section 101.

However, Claims 1, 30, and 35 have been amended solely in order to expedite prosecution of the present application in light of the Examiner's Section 101 rejection. In each of Claims 1, 30, and 35 a step generally directed to *receiving information* has been amended to recite *receiving such information at a processing device* (emphasis added). Applicants respectfully submit that Claims 1, 30, and 35 (and claims dependent therefrom) are directed to statutory subject matter. Accordingly, Applicants respectfully request that the Section 101 rejection be withdrawn.

**Section 103(a) Rejection**

Claims 1-11, 13-15, and 21-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,456,981 issued to Dejaeger, et al. ("Dejaeger"), and further in view of U.S. Patent No. 5,822,744 issued to Kesel, et al. ("Kesel").

Claims 12, 16-20, 28-30, and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Kesel and further in view of U.S. Patent No. 6,567,787 issued to Walker, et al. ("Walker"). Claim 33 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger in view of Walker.

Applicants respectfully traverse the Examiner's Section 103(a) rejections.

**1. Independent Claims 1, 30, 33, and 35**

Applicants respectfully submit that Claims 30, 33, and 35 are not obvious in light of Dejaeger, Kesel, or Walker either alone or in combination.

Each of independent Claims 1, 30, 33, and 35 recites a feature generally directed to *prompting an attendant to present the query [survey question]*.

The Examiner asserts: "It would have been obvious...to further modify the method of Dejaeger by prompting the attendant to transmit the query in order to provide for a more personal transaction without the need to interact with a machine." The Examiner does not indicate any evidence in support of the asserted motivation to "provide for a more personal transaction," much less evidence that such a motivation would have been recognized by one having ordinary skill in the art at the time of invention. The asserted motivation is not suggested in the references.

The Examiner's assertion thus amounts to a mere general statement that the claimed embodiment is advantageous, and that an advantageous embodiment is desirable. This defines impermissible hindsight. The Examiner does not indicate any evidence of a motivation to modify Dejaeger to provide specifically for features generally directed to *prompting an attendant*

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to present the at least first query [survey question]. Accordingly, the Examiner has failed to establish a motivation to modify the cited references to provide for the features of Claims 1, 30, 33, and 35.

In addition, Dejaeger teaches away from such a modification. For example, Dejaeger is directed to a retail terminal for displaying to a given customer customized advertising messages and survey questions. [See, e.g., Column 2, lines 4-10]. The scope and content of a prior art reference must be considered as a whole. The Examiner has not provided any reasoning to explain why one having ordinary skill in the art would be motivated to disregard Dejaeger's focus on displaying messages to a customer using a "display monitor," "communication device," or "retail terminal" (see Column 2, lines 13-64) and instead "provide for a more personal interaction without the need to interact with a machine."

In addition, with respect to Claim 35, Applicants respectfully submit that none of the cited references teach or suggest *instructing the attendant to perform the remediation response*, as discussed above with respect to Claim 27.

Accordingly, Applicants respectfully request the Examiner's reconsideration of the Section 103 rejection of Claims 1, 30, 33, and 35, and all the dependent claims.

## 2. Claims 16, 20, and 28

Applicants respectfully submit that Claims 16, 20, and 28 (and Claims 17 and 18 dependent from Claim 16) are not obvious in light of Dejaeger, Kesel, or Walker either alone or in combination, for at least the reasons stated herein with respect to independent Claims 1, 30, 33, and 35.

Specifically, the Examiner has not provided a motivation to modify Dejaeger in order to provide for a feature generally directed to *prompting an attendant to present a query* (Claim 16), much less *analyzing if the attendant was properly presented* (Claim 20), much less *compensating the attendant for properly presenting the query* (Claim 28). Further, Dejaeger teaches away from eliminating interaction with a machine, the motivation suggested by the Examiner.

## 3. Claim 21

Applicants respectfully submit that Claim 21 is not obvious in light of Dejaeger or Kesel, either alone or in combination. Claim 21 depends from Claim 1 and is believed to be patentable for at least the reasons stated herein with respect to that claim.

### 3.1. using a portable computing device is not shown in the cited references

The Examiner concedes that the cited references do not suggest the feature of *wherein receiving customer information is performed using a portable computing device*. The Examiner asserts, however, that *using a portable computing device* "is notoriously old and well known in the art." Applicants respectfully traverse the Examiner's Official Notice of the recited feature.

The Examiner does not indicate any evidence in support of the assertion that such a feature is "notoriously old and well known in the art."

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### 3.2. No motivation to modify the cited references

The Examiner asserts: "It would have been obvious to further modify the method of Dejaeger by [using a portable computing device] in order to [sic] the customer to retrieve information about items throughout the store." The Examiner does not indicate any evidence in support of the assertion that such a motivation would have been known to one having ordinary skill in the art.

Further, it is not clear to Applicants how a motivation for "the customer to retrieve information about items throughout the store" would suggest *receiving customer information*. Applicants respectfully request that the Examiner clarify this reasoning.

Further, the purported motivation "to retrieve information about items throughout the store" does not even suggest specifically *using a portable computing device*. For example, Dejaeger and Kesel both already suggest multiple fixed terminals "throughout a store."

Accordingly, the Examiner has failed to establish a motivation to make the asserted modification.

### 3.3. Official Notice

The Examiner's rejection of Claim 21 is thus based in part on unsupported general assertions of (i) a "well known" feature and (ii) a motivation to modify presumably known before the time of Applicants' invention. [Office Action, page 5]. Applicants respectfully traverse the Examiner's Official Notice of the asserted subject matter.

Applicants note that the scope of the matter of which the Examiner takes Official Notice is limited to the substantial evidence in the record for such matter. The cited Dejaeger, Walker, and Kesel references do not support the Examiner's broad assertions as to what was well known; the Examiner does not assert otherwise.

No references have been provided for any of the Examiner's assertions. Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the Examiner's brief statement, Applicants cannot properly determine the bounds of the prior art. Accordingly, Applicants dispute that the subject matter asserted was "well known" at the time the invention was made, and request a reference to clarify the subject matter in more detail. MPEP 2144.03.

Accordingly, the Examiner's sweeping assertions cannot be used as prior art to the present application – only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Further, Officially-Noted subject matter cannot be used as the basis for a rejection under 102 or 103. Official Notice may be used, if at all, only to clarify the meaning of a reference. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Typically, it is found necessary to take notice of facts which may be used to supplement or **clarify the teaching of a reference**

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disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching.") (emphasis added).

In other words, Official Notice of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. See, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969) ("Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. ... Allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.") (emphasis added); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. Facts constituting the state of the art in a patent case are normally subject to the possibility of rational disagreement among reasonable men, and are not amenable to the taking of judicial or administrative notice.") (emphasis added); In re Pardo, 684 F.2d 912 (C.C.P.A. 1982) ("[T]his court will always construe [the rule permitting judicial notice] narrowly and will regard facts found in such manner with an eye toward narrowing the scope of any conclusions to be drawn therefrom. Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.") (emphasis added)

### 3.4. Request for clarification

The Examiner asserts that subject matter of Claim 21 "is obvious over that of claim 22." Applicants do not understand the relevance of this statement to the patentability of Claim 21 or Claim 22 and request clarification.

The Examiner also indicates that a "species requirement would be necessary" if Claim 21 "was patentably distinct" from Claim 22. If the Examiner is indicating that a restriction might be necessary, it is Applicants' understanding that restriction practice serves to limit unnecessarily burdensome searching and / or examination. As both Claims 21 and 22 have already been examined, the issue appears moot.

## 4. Claims 27

Applicants respectfully submit that Claim 27 is not obvious in light of Dejaeger or Kesel, either alone or in combination. Claim 27 depends (indirectly) from Claim 1 and is believed to be patentable for at least the reasons stated herein with respect to that claim.

### 4.1. Cited References do not suggest all the features of claim 27

The Examiner concedes that the cited references do not suggest either:

- *identifying a remediation response based on the verbal response to the query*
- *instructing an attendant to present the remediation response*

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as recited in Claim 27. The Examiner asserts, however, that performing such steps "is notoriously old and well known in the art." Applicants respectfully traverse the Examiner's Official Notice of the recited feature.

The Examiner does not indicate any evidence in support of the assertion that such a features are "notoriously old and well known in the art."

**4.2. Asserted general motivation to improve customer satisfaction does not suggest any particular modification**

The Examiner asserts: "It would have been obvious to further modify the method of Dejaeger by [performing the recited features] in order to increase customer satisfaction." The Examiner does not indicate any evidence in support of the assertion that such a motivation would have been known to one having ordinary skill in the art. The motivation is not disclosed in the references.

The Examiner's assertion thus amounts to a mere general statement that the claimed embodiment is advantageous, and that an advantageous embodiment is desirable. This defines impermissible hindsight. The Examiner does not indicate any evidence that the specific features would have been recognized by those skilled in the art, much less a motivation to modify Dejaeger to provide specifically for *identifying a remediation response and instructing an attendant to present the remediation response*. Accordingly, the Examiner has failed to establish a motivation to modify the cited references to provide for such features.

**4.3. Official Notice**

The Examiner's rejection of Claim 27 is thus based in part on unsupported general assertions of (i) "well known" features and (ii) a motivation to modify presumably known before the time of Applicants' invention. [Office Action, page 5]. Applicants respectfully traverse the Examiner's Official Notice of the asserted subject matter and request a reference in support of such subject matter.

**5. Claim 25**

Applicants respectfully submit that Claim 25 is not obvious in light of Dejaeger or Kesel, either alone or in combination. Claim 25 depends from Claim 1 and is believed to be patentable for at least the reasons stated herein with respect to that claim.

**5.1. Cited References do not suggest all the features of claim 25**

The Examiner concedes that the cited references do not suggest *prompting an attendant to select a selected offer from among the plurality of potential offers*, as recited in Claim 25. The Examiner asserts, however, that performing such a step "is notoriously old and well known in the art." Applicants respectfully traverse the Examiner's Official Notice of the recited feature.

The Examiner does not indicate any evidence in support of the assertion that such a feature is "notoriously old and well known in the art."

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The Examiner asserts: "It would have been obvious...to do so in order to provide flexibility and to provide a personal interaction with the customer." The Examiner does not indicate any evidence in support of the assertion that such motivations would have been known to one having ordinary skill in the art. Neither of the motivations is disclosed in the references.

The Examiner's assertion thus amounts to a mere general statement that the claimed embodiment is advantageous, and that an advantageous embodiment is desirable. This defines impermissible hindsight. The Examiner does not indicate any evidence of (i) the specific features would have been recognized by those skilled in the art, much less (ii) a motivation to modify Dejaeger to provide specifically for prompting an attendant to select a selected offer from among the plurality of potential offers. Accordingly, the Examiner has failed to establish a motivation to modify the cited references to provide for the features of Claim 25.

**5.3. Official Notice**

The Examiner's rejection of Claim 25 is thus based in part on unsupported general assertions of (i) "well known" features and (ii) a motivation to modify presumably known before the time of Applicants' invention. [Office Action, page 6]. Applicants respectfully traverse the Examiner's Official Notice of the asserted subject matter and request a reference in support of such subject matter.

**6. Claims 29**

Applicants respectfully submit that Claim 29 is not obvious in light of Dejaeger, Kesel, or Walker either alone or in combination. Claim 29 depends from Claim 27 and is believed to be patentable for at least the reasons stated herein with respect to that claim.

**6.1. Cited References do not suggest all the features of Claim 29**

The Examiner asserts that Dejaeger in view of Kesel "show compensating the attendant for properly presenting the [remediation] response since an employee is compensated for the proper conduct of his job." [Office Action, page 9]. Applicants respectfully traverse this assertion, which itself only refers generally to compensation.

There is no hint in either Dejaeger or Kesel of compensating an attendant specifically for properly presenting a remediation response, as recited in Claim 29. The Examiner does not assert otherwise.

The Examiner asserts that Walker shows the feature of analyzing if the attendant properly presented the remediation response. Applicants have carefully reviewed Walker but have not been able to identify any disclosure suggesting a remediation response, much less analyzing whether an attendant properly presented one. Accordingly, Applicants respectfully traverse the Examiner's assertion.

**6.2. Asserted general motivation to improve customer satisfaction does not suggest any particular modification**

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As discussed above with respect to Claim 27, the Examiner has not suggested a motivation to provide for presenting a remediation response. Accordingly, Applicants respectfully submit that the Examiner has also failed to establish a motivation to analyze whether an attendant has properly presented a remediation response.

Accordingly, the Examiner has failed to establish a motivation to modify the cited references to provide for such features.

7. Claim 13

Applicants respectfully submit that Claim 13 is not obvious in light of Dejaeger or Kesel, either alone or in combination. Claim 13 depends from Claim 1 and is believed to be patentable for at least the reasons stated herein with respect to that claim.

Some embodiments of the present invention provide for a query to be identified based on an authority level or experience level of an employee. [See, e.g., Specification, page 14, lines 13-17; page 16, lines 4-7]. For example, an attendant having an authority level of "LOW" may not be permitted to adlib a survey question.

Claim 13 has been amended to clarify that *a query may be identified based at least in part on an authority level of an attendant*. None of the cited references suggests that a query may be selected based on the authority level of an attendant; the Examiner does not assert otherwise. Applicants respectfully submit that Claim 13 contains allowable subject matter.



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It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).


**Petition for Extension of Time to Respond**

Applicants hereby petition for a ONE-month extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

February 4, 2004  
Date

  
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